

CERTIFICATE OF EXPRESS MAILING

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 Date of Deposit: May 7, 2003

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Dated: May 7, 2003

By: Barbara Bryant
 Barbara Bryant

Patent
 Attorney's Docket No. P-088-R

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)	RECEIVED
M. R. Leadbetter et al.)	MAY 12 2003
Application No.: 09/847,042)	OFFICE OF PETITIONS
Filed: May 1, 2001)	
For: GLYCOPEPTIDE PHOSPHONATE)	
DERIVATIVES)	

**REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
 INDICATED IN NOTICE OF ALLOWANCE (37 C.F.R. § 1.705)**

Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

Sir:

Applicants respectfully request reconsideration of the patent term adjustment indicated on the Notice of Allowance mailed on April 24, 2003, for the above-identified patent application. This paper is being filed before payment of the issue fee.

1. Statement of Facts

Pursuant to 37 C.F.R. §1.705(b)(2), Applicants respectfully submit the following statement of the facts involved:

A. 37 C.F.R. § 1.705(b)(2)(i) and (ii)

The patent term adjustment shown on the Notice of Allowance is 51 days. Applicants respectfully submit that the correct patent term adjustment under §1.702 is 105 days.

The basis on which Applicants seek adjustment is as follows:

(a) Period of Adjustment Pursuant to 37 C.F.R. §1.703

Pursuant to 37 C.F.R. § 1.702(a)(1), the USPTO failed to mail at least one of a notification under 35 U.S.C. §132 or a notice of allowance under 35 U.S.C. §151 not later than fourteen months after the date on which the application was filed under 35 U.S.C. §111(a). Specifically, the date of filing for this application is May 1, 2001; and the USPTO issued a first Office Action on October 16, 2002, resulting in 107 days of USPTO delay.

(b) Reduction of Period of Adjustment Pursuant to 37 C.F.R. §1.704

The period of adjustment (i.e., 107 days) has been reduced for the following two reasons:

(1) Applicants responded to a Notice to File Missing Parts more than three months after mailing of the Notice, i.e., the Notice was mailed on July 2, 2001, and Applicants response was received by the USPTO on August 4, 2001, resulting in 2 days of delay. Applicants are not contesting this period of delay.

(2) On October 16, 2002, an Office Action was mailed by the USPTO. Applicants filed a Reply and Amendment in response to the Office Action by facsimile on January 15, 2003 (i.e., within the three-month period for response). However, the filed response was never entered by the USPTO. On February 11, 2003, and again on March 6, 2003, duplicate copies of the Reply and Amendment were submitted by facsimile to the USPTO. On March 11, 2003, the response was entered and the USPTO attributed 54 days of delay to Applicants.

Applicants respectfully submit that, since a response to the Office Action was submitted to and received by the USPTO within the three-month period set forth in 37 C.F.R. §1.704 (as evidenced by Applicants' facsimile receipt), the reduction of the period of adjustment by 54 days is inappropriate.

Accordingly, this patent application is entitled to a period of adjustment of 105 days (i.e., 107 days less 2 days). Copies of the Office Action (first page showing date mailed); Reply and

Amendment and related transmittal papers (including facsimile cover pages and receipts), and the Determination of Patent Term Adjustment from the Notice of Allowance are attached hereto.

B. 37 C.F.R. §1.705(b)(2)(iii)

This patent application (and the patent issuing from this application) is not subject to a terminal disclaimer.

C. 37 C.F.R. §1.705(b)(2)(iv)

Applicants are not aware of any circumstances during the prosecution of this application that constitute a failure to engage in reasonable efforts to conclude processing or examination of this application as set forth in 37 C.F.R. §1.704, except for the two days of delay discussed above relating to the response to the Notice to File Missing Parts.

D. Summary

Applicants respectfully request that the erroneous attribution of 54 days of delay to Applicants be corrected; and that the patent term adjustment be revised to show that a patent resulting from this application is entitled to 105 days of adjustment.

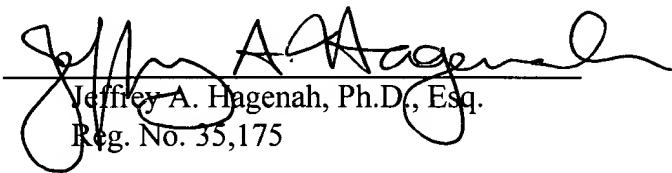
2. Fee Pursuant to 37 C.F.R. §1.18(e)

Pursuant to 37 C.F.R. §1.705(b)(1), a Fee Transmittal is enclosed authorizing the Commissioner to charge the Petition fee of \$200.00 set forth in 37 C.F.R. § 1.18(e) to deposit account 50-0344. The Commissioner is also authorized to charge any additional fees or credit any overpayment to this deposit account. The Fee Transmittal is submitted in duplicate.

Should there be any questions concerning this paper, please contact the undersigned attorney at (650) 808-6406.

Respectfully submitted,

Date: May 7, 2003
THERAVANCE, INC.
901 Gateway Boulevard
South San Francisco, CA 94080
Tel: (650) 808-6000 Fax: (650) 808-6078


Jeffrey A. Hagenah, Ph.D., Esq.
Reg. No. 35,175



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/847,042 05/01/2001 Michael R. Leadbetter P-088-R 5218

27038 7590 10/16/2002

THERAVANCE, INC.
901 GATEWAY BOULEVARD
SOUTH SAN FRANCISCO, CA 94080

EXAMINER

RUSSEL, JEFFREY E

ART UNIT

PAPER NUMBER

1654

DATE MAILED: 10/16/2002

9

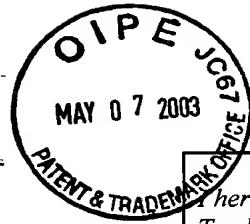
Please find below and/or attached an Office communication concerning this application or proceeding.

Patent Department
OCT 21 2002

RECEIVED
MAY 12 2003
OFFICE OF PETITIONS

COPY

Response Due 1/16/03



CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to the U.S. Patent and Trademark Office, Fax No. (703) 305-3014, on the date shown below:

Dated: 1-15-03

By:


Jeffrey A. Hagenah, Reg. No. 35,175

Patent
Attorney's Docket No. P-088-R

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)
M. R. Leadbetter et al.) Group Art Unit: 1654
Application No.: 09/847,042) Examiner: Jeffrey E. Russel
Filed: May 1, 2001)
For: GLYCOPEPTIDE PHOSPHONATE)
DERIVATIVES)

RECEIVED

MAY 12 2003

OFFICE OF PETITIONS

REPLY AND AMENDMENT PURSUANT TO 37 C.F.R. §1.111

Commissioner for Patents
Washington, D.C. 20231

Sir:

This Reply and Amendment is being filed in response to the Office Action mailed on October 16, 2002, for the above-identified patent application. In response to this Office Action, entry of the following amendments is respectfully requested:



PTO/SB/21 (08-00)

Please type a plus sign (+) inside this box →

Approved for use through 10/31/2002. OMB 0651-0031

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

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TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission	29	Attorney Docket Number	P-088-R
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ENCLOSURES (check all that apply)

<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Amendment / Response <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/ Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Assignment Papers <i>(for an Application)</i> <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group <i>(Appeal Notice, Brief, Reply Brief)</i> <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) <i>(please identify below):</i>				
<table border="1"> <tr> <td>Remarks</td> <td>Attached are the following:</td> </tr> <tr> <td colspan="2"> Reply and Amendment (25 pages) Fee Transmittal (1 page in duplicate) Transmittal Page (1 page - this page) Facsimile Cover Page (1 page) Total Pages: 29 pages </td> </tr> </table>			Remarks	Attached are the following:	Reply and Amendment (25 pages) Fee Transmittal (1 page in duplicate) Transmittal Page (1 page - this page) Facsimile Cover Page (1 page) Total Pages: 29 pages	
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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Jeffrey A. Hagenah, Reg. No. 35,175
Signature	
Date	January 15, 2003

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to the U.S. Patent and Trademark Office, Fax. No. (703) 305-3014, on this date: January 15, 2003

Typed or printed name	Jeffrey A. Hagenah, Reg. No. 35,175
Signature	
Date	1-15-03

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be send to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.



TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

		Application Number	09/847,042
		Filing Date	May 1, 2001
		First Named Inventor	M. R. Leadbetter et al.
		Group Art Unit	1654
		Examiner Name	Jeffrey E. Russel
Total Number of Pages in This Submission	42	Attorney Docket Number	P-088-R

ENCLOSURES (check all that apply)

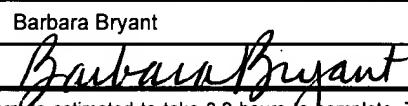
<input checked="" type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Assignment Papers (for an Application)	<input type="checkbox"/> After Allowance Communication to Group
<input type="checkbox"/> Fee Attached	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> Amendment / Response	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	<input checked="" type="checkbox"/> Petition*	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Status Letter
<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address	<input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Terminal Disclaimer	RECEIVED
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> Request for Refund	MAY 12 2003
<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> CD, Number of CD(s) _____	OFFICE OF PETITIONS
<input type="checkbox"/> Response to Missing Parts/ Incomplete Application	Remarks	
<input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<p>*Included in this application (petition) for patent term adjustment are the following: Petition (3 pages); copy of first page of Office Action (1 page); copy of Reply and Amendment (30 pages); copy of Feb. 11, 2003 Facsimile Cover (2 pages); copy of March 6, 2003 Facsimile Cover (2 pages); copy of Determination of Patent Term Adjustment (1 pages); Fee Transmittal (1 page in duplicate); and this Transmittal Sheet (1 page).</p> <p>Total Pages = 42.</p>	

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

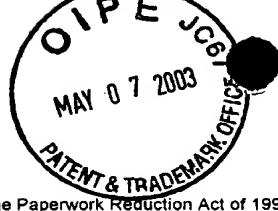
Firm or Individual name	Jeffrey A. Hagenah, Reg. No. 35,175
Signature	
Date	May 7, 2003

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Typed or printed name	Barbara Bryant
Signature	
Date	May 7, 2003

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FEE TRANSMITTAL

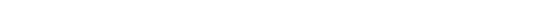
for FY 2003

Effective 01/01/2003. Patent fees are subject to annual revision.

Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ 42

METHOD OF PAYMENT (check all that apply)					FEE CALCULATION (continued)				
<input type="checkbox"/> Check	<input type="checkbox"/> Credit card	<input type="checkbox"/> Money Order	<input type="checkbox"/> Other	<input type="checkbox"/> None	3. ADDITIONAL FEES				
<input checked="" type="checkbox"/> Deposit Account: Deposit Account Number 50-0344					Large Entity		Small Entity		
					Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description
					1051	130	2051	65	Surcharge - late filing fee or oath
					1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet.
					1053	130	1053	130	Non-English specification
					1812	2,520	1812	2,520	For filing a request for reexamination
					1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action
					1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action
					1251	110	2251	55	Extension for reply within first month
					1252	410	2252	205	Extension for reply within second month
					1253	930	2253	465	Extension for reply within third month
					1254	1,450	2254	725	Extension for reply within fourth month
					1255	1,970	2255	985	Extension for reply within fifth month
					1401	320	2401	160	Notice of Appeal
					1402	320	2402	160	Filing a brief in support of an appeal
					1403	280	2403	140	Request for oral hearing
					1451	1,510	1451	1,510	Petition to Institute a public use proceeding
					1452	110	2452	55	Petition to revive – unavoidable
					1453	1,300	2453	650	Petition to revive – unintentional
					1501	1,300	2501	650	Utility issue fee (or reissue)
					1502	470	2502	235	Design issue fee
					1503	630	2503	315	Plant issue fee
					1460	130	1460	130	Petitions to the Commissioner
					1807	50	1807	50	Processing fee under 37 CFR 1.17 (q)
					1806	180	1806	180	Submission of Information Disclosure Stmt
					8021	40	8021	40	Recording each patent assignment per property (times number of properties)
					1809	750	2809	375	Filing a submission after final rejection (37 CFR § 1.129(a))
					1810	750	2810	375	For each additional invention to be examined (37 CFR § 1.129(b))
					1801	750	2801	375	Request for Continued Examination (RCE)
					1802	900	1802	900	Request for expedited examination of a design application
					Other fee (specify) _____				
					*Reduced by Basic Filing Fee Paid				SUBTOTAL (3) (\$ 0)

SUBMITTED BY		Complete (if applicable)			
Name (Print/Type)	Jeffrey A. Hagenah	Registration No. Attorney/Agent)	35,175	Telephone	(650) 808-6406
Signature				Date	January 15, 2003

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Included on this Form: Provide credit card information and authorization on PTO-2038.
This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, Washington, DC 20231.

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O I P E
MAY 01 2003
PATENT & TRADEMARK OFFICE
**FEE TRANSMITTAL
for FY 2003**

Effective 01/01/2003. Patent fees are subject to annual revision.

 Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$)

200

Complete If Known

Application Number	09/847,042
Filing Date	May 1, 2001
First Named Inventor	M. R. Leadbetter et al.
Examiner Name	Jeffrey E. Russel
Group / Art Unit	1654
Attorney Docket No.	P-088-R

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MAY 12 2003

OFFICE OF PETITIONS

METHOD OF PAYMENT (check all that apply)

 Check Credit card Money Other None
Order
 Deposit Account:Deposit
Account
Number

50-0344

Deposit
Account
Name

Theravance, Inc.

The Commissioner is authorized to: (check all that apply)

 Charge fee(s) indicated below Credit any overpayments
 Charge any additional fee(s) during the pendency of this application
 Charge fee(s) indicated below, except for the filing fee
 to the above-identified deposit account.

FEE CALCULATION

1. BASIC FILING FEE

Large Entity	Small Entity	Fee Description	Fee Paid
Fee Code	Fee Code	Fee (\$)	Fee (\$)
1001	2001	375	Utility filing fee
1002	2002	165	Design filing fee
1003	2003	260	Plant filing fee
1004	2004	375	Reissue filing fee
1005	2005	80	Provisional filing fee

SUBTOTAL (1)

(\$ 0)

2. EXTRA CLAIM FEES

Total Claims	Independent Claims	Multiple Dependent	Extra Claims	Fee from below	Fee Paid
			-20 **	= 0	X = 0
			-3 **	= 0	X = 0
				X = 0	

Large Entity

Large Entity	Small Entity	Fee Description
Fee Code	Fee Code	Fee (\$)
1202	2202	9
1201	2201	42
1203	2203	140
1204	2204	42
1205	2205	9

SUBTOTAL (2)

(\$ 0)

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

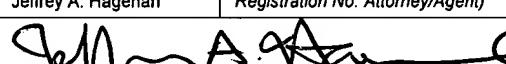
Large Entity	Small Entity	Fee Description	Fee Paid
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1810	2810	750	For each additional invention to be examined (37 CFR § 1.129(b))
1801	2801	750	Request for Continued Examination (RCE)
1802	1802	900	Request for expedited examination of a design application
Other fee (specify) <u>Fee for Filing an application for patent term adjustment specified in 1.18(e) Fee Code 1455</u>			200

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3)

(\$ 200)

SUBMITTED BY

Name (Print/Type)	Jeffrey A. Hagenah	Registration No. Attorney/Agent)	35,175	Telephone	(650) (808)-6406
Signature				Date	May 7, 2003

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